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**OFFICE OF PETITIONS**

BLACK LOWE & GRAHAM PLLC  
701 FIFTH AVENUE, SUITE 4800  
SEATTLE WA 98104

In re Application of	:	
Black, et al.	:	DECISION
Application No. 10/717,736	:	
Filing Date: 20 November, 2003	:	
Attorney Docket No.:BING-1-1046	:	

This is a revised decision on the petition filed on 3 January, 2006, requesting withdrawal of the holding of abandonment under 37 C.F.R. §1.181, alternatively alleging unavoidable delay under 37 C.F.R. §1.137(a) and unintentional delay under 37 C.F.R. §1.137(b).

For the reasons set forth below:

- the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**;
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED** and the petition fee (\$500.00) is charged as authorized to Deposit Account 50-1050; and
- the petition under 37 C.F.R. §1.137(b) is **GRANTED** and the petition fee (\$1,500.00) is charged as authorized to Deposit Account 50-1050.

**BACKGROUND**

The record reflects that:

- Petitioner failed to reply timely and properly to a Restriction Requirement mailed on 25 March, 2005, with reply due absent extension of time on or before 25 April, 2005;

- the application went abandoned after midnight 25 April, 2005;
- Petitioner filed an Election on 27 October, 2005;
- the Office mailed the Notice of Abandonment on 17 November, 2005;
- Petitioner filed Notices of Change of Address on 27 October, 2005, and on 3 January, 2006;
- on 3 January, 2006, Petitioner filed a request to withdraw the holding of abandonment, and alternatively a petition (with fee authorization) to revive alleging unavoidable delay under 37 C.F.R. §1.137(a), and alternatively a petition (with fee authorization) to revive alleging unintentional delay under 37 C.F.R. §1.137(b)–Petitioner avers that a Notice of Change of Address was forwarded to the Office in 2004 (however, Petitioner does not appear to support this with a copy of the paper and a date-stamped receipt card) and, thus, the 25 March, 2005 Office action (Restriction) was mailed to the wrong address;
- Petitioner avers that his new address was included with his recordation of the assignment, however, as one registered to practice before the Office, Petitioner is aware of the requirement under the Rules of Practice that every paper is a separate paper (see: under 37 C.F.R. §1.4<sup>1</sup>); and

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<sup>1</sup> The regulations at 37 C.F.R. §1.4 provide:

**§1.4 Nature of correspondence and signature requirements.**

(a)Correspondence with the Patent and Trademark Office comprises:

(1)Correspondence relating to services and facilities of the Office,such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents or trademark registrations,orders for copies of records,transmission of assignments for recording,and the like,and

(2)Correspondence in and relating to a particular application or other proceeding in the Office.

See particularly the rules relating to the filing,processing,or other proceedings of national applications in subpart B, §§ 1.31 to 1.378;;of international appli-cations in subpart C, §§1.401 to 1.499;of *ex parte* reexaminations of patents in subpart D, §§ 1.501 to 1.570;of interferences in subpart E, §§ 1.601 to 1.690;of extension of patent term in subpart F, §§1.710 to 1.785;of *inter partes* reexaminations of patents in subpart H, §§ 1.902 to 1.997;and of trademark applications §§ 2.11 to 2.189.

(b)Since each file must be complete in itself,a separate copy of every paper to be filed in a patent or trademark application,patent file,trademark registration file,or other proceeding must be furnished for each file to which the paper pertains,even though the contents of the papers filed in two or more files may be identical.The filing of duplicate copies of correspondence in the file of an application,patent,trademark registration file,or other proceeding should be avoided,except in situations in which the Office requires the filing of duplicate copies.The Office may dispose of duplicate copies of correspondence in the file of an application,patent,trademark registration file,or other proceeding.

(c)Since different matters may be considered by different branches or sections of the United States Patent and Trademark Office,each distinct subject, inquiry or order must be contained in a separate paper to avoid confusion and delay in answering papers dealing with different subjects.

(d)(1)Each piece of correspondence,except as provided in paragraphs (e)and (f)of this section, filed in an application,patent file,trademark registration file,or other proceeding in the Office which requires a person's signature, must:

(i)Be an original,that is,have an original signature personally signed in permanent ink by that person;or

(ii)Be a direct or indirect copy,such as a photocopy or facsimile transmission (§ 1.6((d)),of an original.In the event that a copy of the original is filed,the original should be retained as evidence of authenticity.If a question of authenticity arises,the Office may require submission of the original;or

- with the request and petitions, Petitioner re-advances his Election as a reply, but fails to make the regulatory statement as to unintentional delay .

### STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).<sup>2</sup>

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.<sup>3</sup>

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(iii)Where an electronically transmitted trademark filing is permitted,the person who signs the filing must either

(A)Place a symbol comprised of numbers and/or letters between two forward slash marks in the signature block on the electronic submission;  
and print,sign and date in permanent ink,and maintain a paper copy of the electronic submission; or  
(B)Sign the verified statement using some other form of electronic signature specified by the Commissioner.

(2)The presentation to the Office (whether by signing,filing,submitting,or later advocating)of any paper by a party,whether a practitioner or non-practitioner,constitutes a certification under §10.18(b)of this chapter.Violations of §10.18(b)(2) of this chapter by a party,whether a practitioner or non-practitioner,may result in the imposition of sanctions under § 10.18((c)of this chapter.Any practitioner violating § 10.18(b)may also be subject to disciplinary action.See §§10.18(d) and 10.23(c)(15).

(e)Correspondence requiring person 's signature and relating to registration practice before the Patent and Trademark Office in patent cases,enrollment and disciplinary investigations,or disciplinary proceedings must be submitted with an original signature personally signed in permanent ink by that person.

(f)When a document that is required by statute to be certified must be filed,a copy,including a photocopy or facsimile transmission,of the certification is not acceptable.

(g)An applicant who has not made of record a registered attorney or agent may be required to state whether assistance was received in the preparation or prosecution of the patent application,for which any compensation or consideration was given or charged, and if so,to disclose the name or names of the person or persons providing such assistance.Assistance includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent and Trademark Office,as well as other assistance in such matters,but does not include merely making drawings by draftsmen or stenographic services in typing papers. [24 FR 10332,Dec.22,1959;43 FR 20461,May 11, 1978;para.(a),48 FR 2707, Jan. 20, 1983, effective Feb. 27,1983; para. (a), 49 FR 48416, Dec.12, 1984, effective Feb. 11, 1985; para. (a)(2), 53 FR 47807, Nov. 28, 1988, effective Jan. 1, 1989; paras. (d)-(f) added, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; para.(d) revised & para. (g) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; paras. (a)(2) and (d)(1) revised, 64 FR 48900, Sept. 8, 1999, effective Oct. 30, 1999; paras. (b) and (c) revised, 65 FR 54604, Sept. 8, 2000, effective Nov. 7, 2000; para. (a)(2) revised, 65 FR 76756, Dec. 7, 2000, effective Feb. 5, 2001; para. (d)(1)(iii)(A) amended, 67 FR 79520, Dec. 30, 2002, effective Dec. 30, 2002 ]

<sup>2</sup> 35 U.S.C. §133 provides:

**35 U.S.C. §133 Time for prosecuting application.**

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

<sup>3</sup> Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

Delays in responding properly raise the question whether delays are unavoidable.<sup>4</sup> Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).<sup>5</sup> And the Petitioner must be diligent in attending to the matter.<sup>6</sup> Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.<sup>7</sup>))

Allegations as to the Request to  
Withdraw the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.<sup>8</sup>

Petitioner has not satisfied the Delgar requirements.

As to Allegations  
of Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a showing of unavoidable delay, a proper reply, and—where appropriate--a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has not satisfied the showing regulatory requirement as to a petition under 37 C.F.R. §1.137(a).

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<sup>4</sup> See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

<sup>5</sup> See: *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

<sup>6</sup> See: *Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment*, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

<sup>7</sup> Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

<sup>8</sup> See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

As to Allegations  
of Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee if the application was filed before 8 June, 1995.

Petitioner has satisfied the petition, fee and reply requirements under the regulation—the terminal disclaimer requirement is not applicable here. However, Petitioner's statement of unintentional delay does not comport with the regulatory requirements.

**Therefore, Petitioner's incomplete statement of unintentional delay is being read to state that: the entire delay from the due date of the reply to the filing of a grantable petition was unintentional. If this not correct, Petitioner Dale C. Barr (Reg. No. 40,498) must so notify the Office immediately consistent with his duty of candor to the Office.**<sup>9</sup>


With the foregoing presumption, Petitioner is appears to have satisfied the requirements of the regulation.

CONCLUSION

Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, and so the petition as considered under 37 C.F.R. §1.181 hereby is **dismissed**. The petition under 37 C.F.R. §1.137(a) is **dismissed**; and the petition under 37 C.F.R. §1.137(b) is **granted**.

The instant application is forwarded to Technology Center 2800 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



John J. Gillon, Jr.  
Senior Attorney  
Office of Petitions

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<sup>9</sup> See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).